

REMARKS

Claims 1-20 remain active in this application and are subject to a requirement for restriction. No new matter has been introduced into the application.

The Examiner has required restriction between the invention of Group I, claims 1-9, asserted to be drawn to *event handling*, classified in class 719, subclass 318; Group II, claims 10-11 and 16-20, asserted to be drawn to *annotation control*, classified in class 715, subclass 512; Group III, claims 12-14, asserted to be drawn to *authorization*, classified in class 726, subclass 4; and Group IV, claim 15, asserted to be drawn to *process management*, classified in class 718, subclass 1. A provisional election has been made, with traverse, of the invention of Group I. The Requirement for Restriction is respectfully traversed for the reasons set out below.

The Examiner asserts that the inventions are distinct from each other because they are related as sub-combinations disclosed as usable together in a single combination, but are separately usable. The Examiner further asserts that the inventions have acquired a separate status in the art as shown by their different classification.

The invention provides a novel method of integrating additional applications to an existing environment by using an activity chain ontology. The activity chain ontology allows high-level business process integration knowledge to be separated from lower operational level hard coding (page 8, lines 9-10). A business collaboration scenario can be composed from primitives of a collaborative exchange protocol (described in the related application S/N 10/665,699) to automate a sequence of complex interactions between applications in the environment based on annotated messages (page 3, line 19, to page 4, line 8). The activity chain ontology structure allows messages to and from an additional application to be handled "on the fly" as needed, so that more detailed messages do not need to be handled until the further details are actually required

by a later message. The integration activity needed for a particular message can be specified in that message as an annotation (page 5, lines 23-24). In contrast to the prior art (e.g. a RosettaNet or EDI message), the integration action does not need to be pre-defined in a schema to be sent (page 6, lines 18-21).

The implementation mechanism for the invention is built around an action manager (item 12 in Fig. 1), which is isolated from the applications in the environment by an application layer. A new integration activity of an application requires an implementation in the adaptation layer, using the adaptation layer interface. This can be “plugged-in” to the action manager, which itself does not have to be modified and which can then invoke the new application without having to modify the application (page 6, lines 6-13).

Each of the claim groups asserted by the Examiner to be separate inventions address the above summarized invention. The Group I claims (1-9) are a set of method claims structured to follow the activity manager components shown in Figure 4. The Examiner classifies these claims as drawn to “event handling”, but while the messages handled by the action manager may be viewed as “events” any proper examination of these claims, in the context of the specification, would necessarily include the activity chain ontology structure which enables the invention. It is suggested that the Examiner may have taken the terms “event bus” and “events” – which are simply a characterization of the carrier for the messages – and based a classification on these terms without considering the invention as a whole as described in these claims.

Similarly the Group II claims (10-11, 16-20) cover two claim sets (a method set 10-11 and a system set 16-20) focusing on the “annotations”. The annotations are the meta-data that allow dynamic specification of integration activities. Whereas the Group I claims describe “integration activity” without reference to the annotations used to describe this activity, the substance of this aspect of the invention is the same. It is submitted that this variation in terminology is a proper means of making sure that the claims adequately cover the scope of the invention. It is suggested that the Examiner has again taken a

particular term found in the claim language and based a classification on this term without considering the invention as a whole as described in these claims.

Similarly, the Group III claims (12-14) describe the invention in terms of a method for achieving its purpose, namely, connecting legacy applications to a business collaboration solution. The Examiner classifies these claims as drawn to “authorization” under class 726 (“Information Security”), probably because claim 12 refers to the “security checking” performed by the access control facility. However, the access control facility is covered by Group I and Group II claims, although the “security checking” feature is not mentioned explicitly in the Group I claims. Again, this variation in specificity of claim language is a proper means for achieving adequate scope for the invention.

Finally, the Group IV claim (15) is a stand alone Beauregard type claim describing a “medium tangibly embodying a program of machine-readable instructions” for “executing” (from the Group I preamble), “managing” (from the Group II preamble) and “integrating” (from the Group III preamble) the integration activity chain. The Examiner classifies this claim as drawn to “process management”, but this classification is at best a characterization of several aspects of the invention. A proper examination of the claimed invention would necessarily address the “integration activity chain” and the ontology structure implicit therein.

Each of the classes cited by the Examiner addresses an aspect of the invention, but these details separately do not cover the subject matter of the invention as stated in the respective claim sets. In short, the methodology of the Examiner’s classification loses the forest of the invention in the trees. A proper search of any Group should cover at least these aspects, so it is difficult for the Examiner to argue – as he must do for a proper restriction – that there is a serious burden if restriction is not required. Indeed, the Examiner has not, in fact, demonstrated that the searches required for an examination of the respective claim groups would be divergent in any way; rather, the searches would necessarily be largely congruent, regardless of asserted classification. Furthermore, while the

Examiner has asserted that the four restricted claim groups are separately usable, no such demonstration has been made. Clearly, the scope of each of the four groups overlap.

Accordingly, it is respectfully submitted that the above described errors in characterization of the invention prevent a *prima facie* demonstration of independence or distinctiveness of the inventions described in the respective claim groups, as required to properly support a Requirement for Restriction. Additionally, the Examiner has made no *prima facie* demonstration that there would exist a serious burden upon examination in the absence of a Requirement for Restriction. Such a showing is required to properly support a requirement for Restriction. As the Examiner is aware, a *prima facie* demonstration of both a) the independence and distinctiveness of the identified inventions and b) the existence of a serious burden of examination in the absence of such a requirement, must be made in order to support a proper Requirement for Restriction. Further, it is respectfully submitted that the above errors confuse a proper understanding of the invention by drawing artificial lines of distinction between the invention and proper variation in the scope of claims, thereby compromising protection against a double-patenting rejection.

Therefore, it is respectfully submitted that the requirement for restriction is in error and improper and, upon reconsideration, should be withdrawn. However, should the Examiner adhere to the Requirement for Restriction, it is respectfully requested that the requirement be restated in a proper manner accurately recognizing and characterizing the actual subject matter of the identified Groups of claims corresponding to the respective identified inventions, in order to clarify the record and avoid prejudice to the applicants.

Since all requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is in order under 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon such

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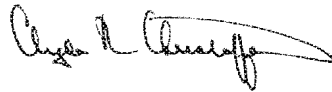
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reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account 50-0510 (IBM-Yorktown).

Sincerely,

A handwritten signature in black ink, appearing to read "Clyde R. Christofferson", with a long, sweeping horizontal stroke at the end.

Clyde R Christofferson
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